

REMARKS

Receipt is acknowledged of the Office Action of December 6, 2004. Claims 1-2, 5-12, and 14-18 are currently pending in the application, Claims 3, 4 and 13 having been cancelled and Claims 14-18 having been added by the present Amendment. Claims 1, 2 and 7-13 have been rejected in the Office Action. Claims 3-6 were objected to by the Examiner, however, the Examiner indicated that the objected claims would be allowable if rewritten in independent form. Applicants have amended the claims, preserving their rights to pursue original claims in a continuation application, and request reconsideration of the rejection, as explained in more detail below.

Applicants thank the Examiner for this early indication of the allowable subject matter. Applicants have amended Claim 1 and added new independent Claim 14 to include the limitations of the allowable Claims 3 and 4, respectively. Thus, Applicants believe that current independent Claims 1 and 14 are patentable over the prior art of record. Dependent Claims 2, 4-11, and 14-18, are believed to define patentable subject matter in view of their dependency upon allowable Claims 1 and 14 and, further, on their own merits.

In the Office Action, Claim 12 was rejected by the examiner under 35 U.S.C. 103 as allegedly being unpatentable over U.S. Patent Application No. 2003/0030340A1 ("Tashiro") in view of U.S. Patent Application No. 2002/0089247A1 ("Ibata et al."). Further, Claim 13 was rejected as allegedly unpatentable over Tashiro in view of Ibata et al. and in view of U.S. Patent No. 6,020,664 ("Liu et al."). Applicants amended Claim 12, cancelled Claim 13 and request a reconsideration of the rejection as explained in more detail below.

In accordance with the amended Claim 12, the present invention is a spindle motor having a baseplate, a rotor, a bearing system having a bearing sleeve directly or indirectly electrically connected to the rotor; and a welding seam providing a permanent electro-conductive connection between the baseplate and the bearing sleeve.

According to the Examiner, Tashiro "substantially discloses the claimed invention, except that the Tashiro's bearing and baseplate is electrically connected via a electrically conductive contact element (15A, 15B) instead of a welding seam." In attempting to cure this deficiency, the Examiner relied on the Ibata reference to show that Ibata allegedly teaches "a motor (figs 1-2) having a welding seam (3) ... provided to the fitted section between baseplate of frame (1) and bearing housing sleeve (2)." The Examiner further observed that "soldering material is a metallic material that generally has electrically conductive characteristics." From this the Examiner concluded that "it would have been obvious to one skilled in the art at the time the invention was made to replace the Tashiro's electrical contact component (15A, 15B) by welding seams between the bearing and the baseplate of the housing, as taught by Ibata."

Additionally, according to the Examiner, Tashiro and Ibata, even in combination, do not disclose the bearing component being the bearing sleeve. Attempting to cure this additional deficiency, the Examiner relied on the Liu reference to show that Liu teaches "a spindle motor having a liquid filled journal bearing (11,21) acts between the base assembly (19) and the rotor hub (16) to provide radial support of the hub (16)." From this the Examiner concluded that "it would have been obvious to one skilled in the art at the time the invention was made to modify the spindle motor by replacing the ball bearing system with a sleeve bearing

system, as taught by Liu." In plain English, the Examiner is proposing to replace the ball bearing system of Tashiro with a journal bearing system of Liu and to provide the bearing sleeve of Liu and a baseplate of Tashiro with an electrically conductive welding seam of Ibara.

The Patent and Trademark Office has the initial burden of producing a factual basis for a rejection under 35 U.S.C. § 103. In other words, the Patent and Trademark Office must establish a prima-facie case for obviousness. If examination does not produce a prima-facie case of unpatentability under § 103, then without more, the applicant is entitled to a grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992). The issue of the prima-facie case for obviousness was recently visited by the Federal Circuit in *In re Thrift*, 63 USPQ 2d 2002. In that case, the Federal Circuit stated the following:

"To establish a prima-facie case of obviousness the Board must, *inter alia*, show some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). 'The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.' *In re Kotzab*, 217 F.3d 1365, 1370, 15 USPQ 2d 1313, 1317 (Fed. Cir. 2000)." 63 USPQ 2d at 2006.

In the well known case, *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), the Court addressed the issue of whether a case for prima-facie obviousness had been established. In that case, the Examiner sought to apply U.S. Patent No. 1,175,948 to French which discloses "a liquid strainer for removing dirt and water from gasoline and other like oils." 221 USPQ at 1127. In the French strainer, disclosure is made that the straining action relies "at least in part, upon the assistance of gravity to separate undesired dirt and water from gasoline and other like oils." *Id.* In attempting to apply the French patent against the claims on appeal, the Examiner

proposed inverting the French strainer. The Federal Circuit concluded that such a ground of rejection failed to establish prima-facie obviousness. *Id.* The Court stated that:

“[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *Id.*

“Indeed, if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose. The gasoline to be filtered would be trapped in pocket 9, and the water French seeks to separate would flow freely out of the outlet 5. Further, unwanted dirt would build up in the space between the wall of shell 1 and screen 21, so that, in time, screen 21 would become clogged unless a drain valve, such as pet-cock 13, were re-introduced at the new ‘bottom’ of the apparatus. . . In effect, French teaches away from the Board’s proposed modification. Because the PTO has failed to establish a prima-facie case of obviousness, the rejection of Claims 1-3 and 5-7 as unpatentable under 35 U.S.C. § 103 must be *reversed*.” *Id.*

Thus, in *In re Gordon*, the Federal Circuit held that where the prior art applied against the claims on appeal, as applied, was rendered inoperable for its intended purpose, no prima-facie case for obviousness had been established.

In *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966), the U.S. Supreme Court announced the test that has since become the standard guideline for assessing patentability under 35 U.S.C. § 103. Under that section of the Patent Statutes, the Supreme Court stated that the inquiry was as follows:

“The scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” 383 US at 17.

The inquiry as to when the issue of obviousness is to be resolved is that the inquiry is conducted “at the time the invention was made.” 35 U.S.C. § 103(a). In attempting to reject

claims under 35 U.S.C. § 103, there must be a reason or suggestion in the art for making the combination of features suggested by the Examiner other than knowledge learned from applicant's own disclosure. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1532 (Fed. Cir. 1988). The test to be applied is whether the references taken as a whole would suggest the invention to one of ordinary skill in the art. *Medtronic Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1582, 220 USPQ 97, 110 (Fed. Cir. 1983). Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. *Gillette Company v. S.C. Johnson & Son, Inc.*, 16 USPQ 2d 1923, 1927 (Fed. Cir. 1990). A determination of obviousness must involve more than indiscriminately combining prior art; a motivation or suggestion to combine must exist. *Micro Chemical, Inc. v. Great Plains Chemical Company*, 41 USPO 2d 1238, 1244 (Fed. Cir. 1997). Inherent in the forbiddance of the use of hindsight is the forbiddance of picking and choosing various features of different prior art references as a mosaic to recreate a facsimile of the claimed invention without a suggestion to combine them together in the references taken as a whole. *Akzo N.y. v. United States ITC*, 808 F.2d 1471, 1481, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986). Where the Examiner has picked and chosen various features from separate prior art references and has combined them together using applicant's own disclosure as the blueprint to do so, such a rejection is fatally flawed and must be reversed. *Heidelberger Druckmaschinenag v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 1072, 30 USPQ 2d 1377, 1379-80 (Fed. Cir. 1994); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). It is improper to use the inventor's patent application as an instruction book on how to reconstruct the prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1574, 1 USPQ 2d 1593, 1602 fn29 (Fed. Cir. 1987).

Applicant respectfully submits that the Examiner has failed to present a prima-facie case

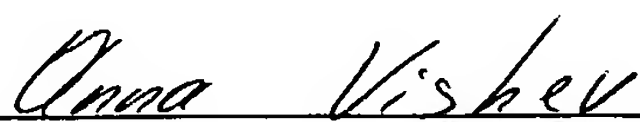
for the obviousness of the rejection of Claim 13 (corresponding to the amended Claim 12) relying upon three separate prior art references, the U.S. Patent Applications and the U.S. Patent to Tashiro, Ibata and Liu. At the onset, it is submitted that Tashiro fails to include any of the structural details of the bearing sleeve until those features are provided by Liu. When the Examiner takes the next step and adds the teachings of the Ibata to provide the welding seam to ball bearing structure of Tashiro (or is it the journal bearing structure of Liu?), the Examiner falls well short of showing a prima-facie case for obviousness.

Based on the above, Applicant believes that current Claim 12 is patentable over the cited prior art.

The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-0675, Order No. 057517-14.

Respectfully submitted,

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